

**REMARKS**

Claims 1-16 and 25- 32 remain in the application for further prosecution. Claims 17-24 have been cancelled. Claims 17-24 have been withdrawn without prejudice or disclaimer. The Applicants confirm that the inventorship for the remaining claims has not changed.

The Applicants reserve the right to file the cancelled claims in a divisional application.

**Restriction/Election Requirement**

The Examiner stated that “[t]his application contains claims directed to the following patentably distinct species: Species A: Figure 1-3. Species B: Figure 4a-4c. Species C: Figure 5a-5c. Species D: Figure 4a-4c. Species E: Figure 6-8. Species F: Figure 9” and states that “[t]he species are independent or distinct because a text search for one species does not overlap with a text search for any of the other respective species”

**Applicant traverses this restriction requirement.**

**I. A PRIMA FACIE CASE SUPPORTING RESTRICTION HAS NOT BEEN SET FORTH**

As discussed in MPEP § 802.01, 35 U.S.C. 121 and 37 CFR 1.141 provide that the Director may require restriction if two or more “independent and distinct” inventions are claimed in one application. Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure or method of manufacture), operation (e.g., function or method of use), or effect. Related inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art).

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent or distinct as claimed; and
- (B) There would be a serious burden on the examiner if restriction is not required.

See MPEP §§ 803, 808.01(a) (citations omitted).

**The Examiner has not satisfied either prong of this requirement.**

As to the first prong, the Examiner has not shown that the inventions “must be independent or distinct as claimed.” Where there is no disclosure of a relationship between species (*see MPEP § 806.04(b)*), they are independent inventions. The Examiner has not demonstrated independence by showing that there is “no disclosure of a relationship between species,” such as by demonstrating that the asserted species are “unconnected in design, operation, and effect.” A showing that the asserted species are “unconnected in design, operation, and effect” is an essential component of both independence and distinctness. See MPEP § 802. Applicant submits that the failure of the Examiner to show how each of the alleges species are “unconnected in design, operation, and effect” renders the imposed restriction requirement improper for at least this reason.

Once the Examiner has satisfied the first prong, which Applicant submits that he has not, the Examiner must address the second prong and show (i.e., present proof of) that “[t]here would be a serious burden on the examiner if restriction is not required.” As stated in MPEP § 803, “a serious burden on the examiner may be *prima facie* shown \*\* by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.” *Id.* (underlining added). In this case, the Examiner has not provided an appropriate explanation of separate classification, or separate status in the art, or a different field

of search. Instead, the Examiner has merely presented a conclusory statement that “a text search for one species does not overlap with a text search for any of the other respective species.”

MPEP § 808.02(C), which states that “[w]here the \* inventions as claimed are shown to be independent or distinct under the criteria of **MPEP § 806.05(c) - § 806.06**, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required” and that “the examiner must show by appropriate explanation one of the following: (A) **Separate classification thereof:** This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification. (B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search. (C) **A different field of search:** Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.” (emphasis in original). The Examiner has not presented any evidence regarding classification and has not shown different field(s) of search are required. Moreover, the Examiner has not shown how any such alleged differences in classification realistically impose a “serious burden” on the Examiner.

Therefore, for the above reasons, Applicant submits that the Examiner's restriction requirement is manifestly improper. The Examiner is respectfully requested to withdraw the finality of the restriction requirement and consider the application in its entirety. A Petition to the Commissioner to review the requirement under 37 C.F.R. § 1.144 will be held in abeyance pending notification of such reconsideration and withdrawal thereof by the Examiner.

## **II. THE RESTRICTION REQUIREMENT IS INTERNALLY FLAWED AND SUSPECT**

In the Examiner's recitation of the allegedly patentably distinct species, the Examiner cites as patentably distinct "Species B: Figure 4a-4c. . . . Species D: Figure 4a-4c."

Thus, "Species B" and "Species D" are the same. Applicant submits that this clearly erroneous assertion immediately calls into question the validity of the restriction requirement.

## **III. ELECTION OF SPECIES**

Despite Applicant's traversal, Applicant recognizes that it "must elect a single disclosed species even if applicant disagrees with the examiner's restriction requirement." **MPEP § 808.01(a).** Accordingly, Applicant elects, with traverse, the alleged "Species E: Figure 6-8."

Consistent with the requirement that the Applicant must include "a listing of all claims readable thereon," Applicant submits that claims 1-16 and 25-32 appear to correspond to the elected Species E.

## **IV. CONCLUSION**

Applicant requests reconsideration of and withdrawal of the above-described restriction requirement.

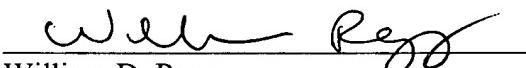
It is the Applicants' belief that all of the claims are in condition for allowance and action towards that effect is respectfully requested.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is believed that no fees are due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkens & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47171-00390USPT.

Respectfully submitted,

December 22, 2006  
Date

  
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